

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl No. : 10/090,685
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TC/A.U. : 3711
Examiner : Vishu K. Mendiratta
Docket No. : 07-2176-A
Title : SPIN KENO

Confirmation No. 8496

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Before the Board of Patent Appeals and Inferences:

This Reply Brief is respectfully submitted in response to the Examiner's Supplemental Answer of June 16, 2009. Applicants file this Reply Brief pursuant to 37 C.F.R. § 41.50(a)(2)(ii) in order to maintain the appeal as to dependent claims 37-38 and 44-46 in particular, and as to all pending claims (25-48 and 50-52) in general.

With respect to fees, Applicants believe that no fee is due. However, any underpayment is authorized to be charged to Deposit Account No. 132490.

STATUS OF CLAIMS

Claims 25-48 and 50-52 are currently pending, of which claims 25, 29, 39, 47, and 50 are independent. Claims 1-24 and 49 were withdrawn in response to an election requirement. All of the pending claims currently stand rejected and on appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

1. Claims 25-48 and 50-52 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,702,671 (Tarantino).
2. Claims 25-48 and 50-52 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,401,024 (Simunek).
3. Claims 37-38 and 44-46 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Simunek and Tarantino.

Please note that this Reply Brief is being filed to address the third grounds of rejection listed above, as this was the grounds of rejection addressed in the Supplemental Examiner's Answer mailed June 16, 2009, which the Examiner issued at the direction of the February 25, 2008 decision of the Board of Patent Appeals and Interferences ("the Board"), remanding this matter to the Examiner for consideration.

ARGUMENT

Sequence of Events Leading to this Reply Brief

On August 1, 2005, the Examiner mailed a Final Office Action, which rejected the pending claims according to the three grounds of rejection listed on the previous page of this Reply Brief.

On June 8, 2006, Applicants filed an Appeal Brief, which correctly stated the first two grounds of rejection listed on the previous page of this Reply Brief, but incorrectly stated the third ground as being with respect to all pending claims (25-48 and 50-52); Applicants' Appeal Brief included arguments with respect to that incorrect ground of rejection.

On September 5, 2006, the Examiner's mailed an Examiner's Answer, which incorrectly stated that the Appeal Brief had correctly stated the grounds of rejection to be reviewed on appeal. However, the Examiner then presented his position regarding the correct third ground of rejection, and also asserted that Applicants' arguments with respect to the incorrect ground of rejection were moot.

On November 3, 2006, Applicants filed a Reply Brief, correcting their earlier mistake by acknowledging and presenting arguments regarding the correct third ground of rejection.

On January 24, 2007, the Examiner mailed Applicants an acknowledgement that the Reply Brief of November 3, 2006 had been entered and considered, noting that the application had been forwarded to the Board for decision on the appeal.

On February 20, 2008, an Oral Hearing was held on this application, with attorney Michael Baniak appearing on behalf of Applicants.

On February 25, 2008, the Board issued an Order remanding the case to the Examiner for consideration and possible response to the Applicants' arguments made with respect to claims 37-38 and 44-46 in the November 3, 2006 Reply Brief.

On June 16, 2009, the Examiner mailed a Supplemental Answer, stating the Examiner's positions with respect to the arguments referenced in the preceding paragraph.

Introduction to Applicants' Response to the Examiner's Supplemental Answer

Pursuant to 37 C.F.R. § 41.50(a)(2)(ii), Applicants respectfully submit this Reply Brief in response to the Examiner's Supplemental Answer mailed June 16, 2009, in order to maintain the appeal with respect to dependent claims 37-38 and 44-46 in particular, and with respect to all of the pending claims (25-48 and 50-52) in general.

With respect to all three grounds of rejection currently being reviewed on appeal, Applicants respectfully reiterate and stand by the arguments made during prosecution before the Examiner and on appeal before the Board. In addition, Applicants respectfully make the following arguments with respect to dependent claims 37-38 and 44-46.

Claims 37-38 and 44-46 are Patentable Over the Combination of Simunek and Tarantino

Applicants note at the outset that claims 37-38 depend from independent claim 29, and therefore respectfully submit that claims 37-38 are allowable for at least the same reasons that claim 29 is allowable; Applicants further note that claims 44-46 depend from independent claim 39, and therefore respectfully submit that claims 44-46 are allowable for at least the same reasons that claim 39 is allowable. Applicants respectfully submit that Applicants have convincingly demonstrated the allowability of claims 29 and 39 during prosecution and before the Board, including but not limited to in the Appeal Brief filed June 8, 2006, in the Reply Brief filed November 3, 2006, and at the Oral Hearing on February 20, 2008, and thus Applicants do not reproduce those arguments here in their entirety, but rather highlight certain of those arguments below where relevant.

In particular, in the Supplemental Answer of June 16, 2009, the Examiner, in discussing the rejections of claims 37-38 and 44-46 under § 103(a) as unpatentable over the combination of Simunek and Tarantino, states that the Examiner was using Simunek as the primary reference, and was relying on Tarantino to provide those aspects not taught by Simunek. As such, Applicants remind the Board that claims 37-38 depend from claim 29, and that claims 44-46 depend from claim 39, and that both claim 29 and 39 recite the following aspects not found in Simunek: “determining a game element indicium from a set of gameplay indicia to be displayed in at least said selected game element locations for a gameplay condition...; determining an outcome...based upon said gameplay condition.”

Thus, according to claims 29 and 39, a player selects less than all of the game element locations presented to the player as options for selection, and then all of the locations selected by the player are played (i.e. have an indicium randomly assigned to them from a set of indicia) to an outcome. Examiner has taken the position that, because this is remotely but theoretically possible in Simunek’s game, that Simunek’s game anticipates or renders obvious Applicants’ inventive game. Applicants respectfully submit that a player’s experience would be very different with respect to the two games, as a player of Simunek’s game would only have all of their selected locations played towards an outcome in the rarest of circumstances, and likely never, whereas this would happen with every single play of Applicants’ game. Simply put, they are different games, and Simunek’s game cannot anticipate or render obvious Applicants’ game.

Thus, Applicants respectfully submit that, because claim 29 is allowable over Simunek, that dependent claims 37-38 are as well, and whether Tarantino provides random assignment of indicia to both selected and unselected game locations (claim 37), or winning conditions such as certain spatial arrangements (also claim 37) such as horizontal, vertical, or diagonal (claim 38) is not dispositive as to the allowability of claims 37-38, as the combination of Simunek and

Tarantino would not provide all elements of either of those claims, when read in their entirety as incorporating all limitations of claims from which they depend.

Similarly, Applicants respectfully submit that, because independent claim 39 is allowable over Simunek, that dependent claims 44-46 are as well, and whether Tarantino provides a plurality of paytables of increasing value (claim 44), or wagers based on aggregate number of game element locations selected and wagered amount per location (claim 45), or wagers based on aggregate number of reels selected and wagered amount per reel (claim 46) is not dispositive as to the allowability of claims 44-46, as the combination of Simunek and Tarantino would not provide all elements of either of those claims, when read in their entirety as incorporating all limitations of claims from which they depend.

One of Skill in the Art Would Have No Reason to Combine Simunek and Tarantino

Furthermore, Applicants wish to reiterate at least some of their previous arguments with respect to how one of skill in the art would not be led to combine Simunek and Tarantino. In particular, one of skill in the art would have no reason to combine (a) Simunek, a game where locations in common between player-selected locations and randomly-selected locations turn into a slot reel display for spin with (b) Tarantino, a game disclosing a matrix of die elements where a player attempts to achieve a predetermined combination of die indicia, and where a player really has no “select some from among more” choice as to which game elements will be played, as that is deterministic based on sequential wagering decisions.

It is difficult for Applicants to see why one of skill in the art would be led to combine a reference (Simunek) teaching player selection of less than all then-available gameplay locations and a single bet with a reference (Tarantino) teaching no option for player selection of less than all then-available gameplay locations and serial betting to play more locations. Applicants

respectfully submit that applying either reference's paradigm to the other would so change the other as to give one of skill in the art no reason to combine them. Thus, Applicants respectfully submit that any rejections of any of Applicants' pending claims based on a combination of Simunek and Tarantino (in either order) are inapposite.

Conclusion

Applicants respectfully submit that all pending claims, including dependent claims 37-38 and 44-46, are allowable over the art of record, and Applicants respectfully request reversal by the Board of all pending grounds of rejection, and allowance of all pending claims.

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Respectfully submitted,

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